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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,261	07/06/2001	Yasuhiro Yoshioka	0649-0789P-SP	3458
2292	7590	08/18/2003		15
BIRCH STEWART KOLASCH & BIRCH			EXAMINER	
PO BOX 747			CHEA, THORL	
FALLS CHURCH, VA 22040-0747				
		ART UNIT	PAPER NUMBER	
		1752		
DATE MAILED: 08/18/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/899,261	YOSHIOKA, YASUHIRO
	Examiner Thorl Chea	Art Unit 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 July 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toya. See the surfactant in columns 15-17, especially column 17 lines 30-45; column 19, lines 35-50, and the combination of phthalazine and phthalic acid in column 7, lines 23-25. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the combination of phthalazine and the phthalic acid to pleasing image tone of the material taught therein to provide a material as claimed.

3. Claims 1-2, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Moon and Kirk et al (Kirk). See the surfactant taught in Moon in column 21; claim 1 compound formula (III), and examples in column 17-18, and the toning agent in column 12 including the phthalazine and phthalic acid using as tone modifier and to provide more uniform and pleasing image tone. Kirk in column 11 lines 60-65 discloses a combination of toner including the combination phthalazine and phthalic acid. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known tone modifiers including the combination of

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phthalazine and phthalic acid tone to provide the material of Moon with more uniform and pleasing tone to provide an invention as claimed.

4. Claims 3-4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toya or Moon as applied to claims 1-2, 5-7 above, and further in view of Matsumoto et al (Matsumoto), and Milton.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toya and Moon in view of Matsumoto et al (Matsumoto), Kirk and Milton. The polyhalogenated compound in claim 4 and the phosphorous compound in claim 3 has been known in Matsumoto, Kirk and Milton as antifoggant for silver halide emulsion. It would have obvious to the worker of ordinary skill in the art at the time the invention was made to include the antifoggant taught in Matsumoto, Kirk and Milton in the material of Toya or Moon to improve its fogging property, and thereby provide the invention as claimed.

#### ***Response to Arguments***

6. It is the Examiner's position that the claimed invention is *prima facie* obvious over the applied prior art of record. The surfactant in column 17, line 38 is within the scope of the present claimed invention. The surfactant contains an anionic group (-SO<sub>3</sub><sup>-</sup> Na), an alkylene group -(CH<sub>2</sub>)<sub>4</sub>- and C<sub>8</sub>F<sub>17</sub><sup>-</sup>.

The applicants argue that the compound F claimed in the present claimed invention contains an alkylene group bonded directly to the perfluoroalkyl group. It appears that the applicants mean that the compound taught in Toya contains the alkylene group of

the formula taught in Toya connected to perfluoroalkyl group through the other group such as  $-\text{SO}_2\text{N}(\text{C}_3\text{H}_7)(\text{CH}_2\text{CH}_2\text{O})_4-$ .

It is the Examiner's position that the argument is not well taken. The specification as considered as a whole fails to exclude the group other than the alkylene group from the compound F. Note for instance on page 10 of the specification, compound FS-6 to FS-10, FS-13 and the definition of alkylene group on page 8 last paragraph to page 9 first paragraph wherein  $\text{R}_c$  group may be bonded to the group necessary for imparting a surface activity in Z bonding form, such as they may be bonded directly or may be bonded via an alkylene group, an arylene group etc., which may have a substituent and/or have an oxy group, a thio group, a sulfonyl group, a sulfoxido group, a sulfoamido group, amido group, an amino group, a carbonyl group etc., at the main chain or side chain. Therefore, the surfactant taught in Toya is within the scope of the compound F having an anionic group claimed in the present claimed invention. Moreover, Toya discloses the combination of phthalazine and phthalic acid as toning agent in column 7, lines 24.

The argument with the unexpected results is not persuasive. First, the results are irrelevant to the closest prior art of record, especially Toya especially the examples 2 in columns 15-16 which contains a phthalazinone as toner and the surfactant in the topcoat layer in column 17. The composition of the claimed invention and that taught Toya differs only the use a combination of toner which is the phthalazine compound and phthalic acid. The comparative samples shown in the specification disclosure is related to the use of the phthalazine compound in the imaging layer and the phthalic acid

in the protective layer, while the scope of the claimed invention encompasses the use of the use of a combination of in a same layer in the imaging layer taught in Toya. Second, the results shown in the specification disclosure is not commensurate with the scope of the claimed invention. The comparative material encompasses base formula which is outside the scope of the claimed invention, which is not presented in the claimed invention. See base formula (1), (2).

***Conclusion***

7. Cite of interest: Matsunaga discloses a fluro-containing compound containing a nonionic, anionic, cationic and betain-type functional group as hydrophilic group in columns 15, lines 44-65 to column 16 in silver halide photographic light-sensitive material.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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August 9, 2003

  
Thor Chea  
Primary Examiner  
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